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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Noah J. Ternullo et al.	TC/A.U.:	2157
Appl. No.:	09/929,995	Examiner:	Sargon N. Nano
Filed:	August 15, 2001	Confirmation No.:	9105
Docket No.:	12078-142	Customer No.:	26486
Title:	METHOD AND APPARATUS FOR DELIVERING SERVICES IN A CONSTRAINED ENVIRONMENT		

Re: Pre-Appeal Brief Request for Review

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW UNDER THE EXTENSION OF THE  
PILOT PRE-APPEAL BRIEF CONFERENCE PROGRAM**

Sir:

Pursuant to the Extension of the Pilot Pre-Appeal Brief Conference Program, which is extended until further notice (OG Notices, 2-7-2006), and further to the Final Rejection of September 24, 2008, Applicants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

**Claim 1:**

Claim 1 recites, among other things, "formatting, outside the client device, substantially all unsolicited advertising information from the advertisement into XML elements" that include "service information", "data entry information", and "contact information". The Final Rejection states, on page 14, that Claim 1 is unpatentable over Hendrey in view of Camaisa in further view of Official Notice because "extensible markup languages are old and well known in the art as evidenced by Lewontin, United States Patent Application # 2002/0087596", filed December 29, 2000 (Lewontin), which was cited in response to Applicants' traversal of the Office Notice rejection on page 4 of the Office Action of November 19, 2007. The citation by the Examiner of Lewontin was provided since Applicants adequately traversed the Examiner's assertion of Official Notice. As set forth in 37 CFR § 1.104(c)(2), the examiner must provide documentary evidence in the next Office Action if the

rejection is to be maintained. It is submitted that the Examiner has not complied with this requirement since Lewontin does not support the rejection based on Official Notice because Lewontin was filed on December 29, 2000, over four months after the filing date of Applicants' provisional patent application serial # 60/225,349, of August 15, 2000, upon which the present utility patent application relies for priority. **Lewontin was not available** at the time of Applicants' provisional patent application filing. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known [at the time of the invention]." MPEP § 2144.03(a)(p2) [Emphasis in original]

It is further submitted that the modification of Hendrey in view of Camaisa renders Hendrey unsuitable and inoperable for the purpose it was intended for. "If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); see also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose)" (as cited in *Tec-Air Inc. v. Denso Manufacturing*, 192 F.3d 1353, 1360 (Fed. Cir. 1999).) In *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007), the Court identified "teaching away" as a strong indicator of nonobviousness.

Further supporting the patentability of the claims is the fact that although Applicants argued that Hendrey could not be modified by Camaisa, **the Final Rejection did not address Applicants' arguments**, which are summarized herein.

Hendrey states a device usable by prospective patrons progressing from store to store and receiving advertisements that are timely for the position of prospective patron. If modified/combined by/with Camaisa, the advertisements would be blocked when the user fills out, for example, a menu request, and therefore it would be impossible for Hendrey to produce timely advertising. There is no capability disclosed by either Hendrey or Camaisa that could allow incoming advertisements while a user is filling in a form, and thus, the modification of Hendrey to include Camaisa would render Hendrey unsuitable for its intended purpose, which teaches away from the combination, which is a strong indicator of nonobviousness. See *In re Spinnoble* and *KSR* above.

Based on the addition of the term "substantially" in the previous Office Action response, Claim 1 was rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. Although Applicants believe that the

term is fully supported in Applicants' Specification, paragraphs 63-66, Applicants are prepared to amend the claim to delete the term "substantially", without prejudice, if necessary to place the case in condition for allowance.

### **Claims 10 and 13**

With respect to dependent claims 10 and 13, it is submitted that Hendrey in view of Camaisa do not make obvious Applicants' claimed receiving a service response from the transmitter or POP, the service response including executable code for allowing the client device to interact with the service, because (1) nowhere does Hendrey disclose or suggest that executable code is transmitted by a transmitter to Hendrey's mobile unit, and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa does not disclose or suggest that executable code is transmitted from Camaisa's CPU to Camaisa's remote terminal. The Final Rejection states on page 15 that "Hendrey's executable codes are inherently included in information being transferred in the telecommunications system", but does not address the distinction between executable code and data. The MPEP states that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *MPEP* § 2112 (IV). Hendrey Hendrey limits the transmissions between the tracking system and the mobile unit to "data" (Hendrey, col. 8, line 64 – col. 9, line 10).

### **Claims 15, 19, 23, 24, 29, 33, 34, 35, 38-42, and 47**

Each of the above-listed claims was argued in the response to the non-final rejection of November 19, 2007, but **none of the arguments were answered in the Final Rejection**. Following is a summary of the arguments presented in the non-final rejection response filed on May 16, 2008. The complete arguments may be found in pages 13-17 of the non-final rejection response.

#### *Claims 15, 23, and 33*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed step of conveying unsolicited information from a transmitter as an optical signal or a diffuse infrared signal having a wavelength range of 850-1250 nanometers because neither Hendrey nor Camaisa describes the interface between the mobile unit or client and the telecommunication system infrastructure beyond the obvious requirement that the mobile unit have a wireless interface.

*Claims 19, 24, and 38-40*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed transmitter outside the client device having a link layer (independent claim 19), or a client device physical layer and a client device link layer compatible with the link layer in the transmitter (dependent claim 24), because neither Hendrey nor Camaisa describe any transmission layers, including a link layer, in the transmitter or client device.

*Claims 22 and 32*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed unsolicited information or advertisement conveyed from the transmitter as a diffuse infrared signal because (1) Hendrey teaches away from a diffuse infrared signal because there are no restrictions on where the recipient of the advertisement can be physically located, and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa states no restrictions on the recipient either.

*Claim 29*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed steps of receiving an advertisement in the transmitter from a service provider and conveying the advertisement by the executable code in the transmitter to the client device because (1) Hendrey does not receive advertisements and convey them by any means, but simply prepares advertisements and conveys them, and (2) Camaisa does not make up this deficiency in Hendrey because Camaisa does not receive advertisements and convey them but instead displays menus, which are neither advertisements, nor are they conveyed.

*Claim 34*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed diffuse infrared signal generated by modulating an electric light because (1) Hendrey does not describe how the wireless signal is generated, and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa does not describe diffuse infrared or how the wireless signal is generated.

*Claim 35*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed step of receiving the unsolicited, formatted advertisement from an infrared communication signal conveyed from the transmitter, wherein the transmitter formatted the

advertisement because (1) Hendrey does not format the advertisement but instead creates it, and (2) Camaisa does not disclose a transmitter that formats an advertisement.

*Claim 41*

It is submitted that modifying Hendrey in view of Camaisa does not make obvious Applicants' claimed wherein the information about the service is displayed to the user if the client device is running a plug-in cooperatively associated with the service because neither Hendrey nor Camaisa describe a conditional display based on a plug-in running in a mobile unit or client.

*Claim 47*

It is submitted that modifying Hendrey in view of Camaisa in further view of Kahn does not make obvious Applicants' claimed determining, by the client device, a user response to the predetermined information from user eye movement because (1) Hendrey and Camaisa fail to teach the user response in the form of eye movement, and (2) Kahn does not make up for Hendrey's and Camaisa's deficiencies because Kahn doesn't interface with a wireless device, and nothing in the prior art as a whole suggests the desirability of modifying Hendrey with Camaisa and Kahn, and in fact Hendrey teaches away from such a combination because Hendrey's purpose is to present information to the user, not to accept user input. As stated previously, Hendrey cannot be modified by Camaisa without rendering Hendrey unsuitable for its intended purpose.


In conclusion, Applicants respectfully request that the claims of the present application be found allowable for the reasons provided above and in Applicants' prior arguments, and that the case be passed to issue.

The Commissioner for Patents is authorized to charge additional fees, including a large entity fee for an extension of time, or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-142. The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,

Noah J. Ternullo et al., Applicants

Date: December 24, 2008

By:   
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